

1 BRETT M. SCHUMAN (State Bar No. 189247)  
2 DION M. BREGMAN (State Bar No. 208393)  
3 AHREN C. HSU-HOFFMAN (State Bar No. 250469)  
4 RYAN L. SCHER (State Bar No. 244706)  
5 MORGAN, LEWIS & BOCKIUS LLP  
One Market, Spear Street Tower  
San Francisco, CA 94105-1126  
Tel: 415.442.1000  
Fax: 415.442.1001  
E-mail: [bschuman@morganlewis.com](mailto:bschuman@morganlewis.com)  
E-mail: [dbregman@morganlewis.com](mailto:dbregman@morganlewis.com)  
E-mail: [ahoffman@morganlewis.com](mailto:ahoffman@morganlewis.com)  
E-mail: [rscher@morganlewis.com](mailto:rscher@morganlewis.com)

8 Attorneys for Plaintiff and Counterclaim-Defendant  
OPENWAVE SYSTEMS INC.

UNITED STATES DISTRICT COURT  
NORTHERN DISTRICT OF CALIFORNIA  
SAN FRANCISCO DIVISION

14  
15 OPENWAVE SYSTEMS INC., Plaintiff,

V.

MYRIAD FRANCE S.A.S.,

## Defendants.

Case No. 10-CV-02805 (WHA)

**PLAINTIFF'S ANSWER TO  
DEFENDANT'S FIRST AMENDED  
COUNTERCLAIM**

MYRIAD FRANCE S.A.S..

### **Counterclaimant.**

V.

23 OPENWAVE SYSTEMS INC.,  
Counterclaim-  
Defendant

1 Plaintiff and Counter-Defendant OPENWAVE SYSTEMS INC. (“OPENWAVE”) hereby  
 2 responds to and answers the first amended counterclaim of Defendant and Counterclaimant  
 3 MYRIAD FRANCE S.A.S. (“MYRIAD”), which appears beginning at page 5 of MYRIAD’s  
 4 Answer to Second Amended Complaint and First Amended Counterclaim (Dkt. No. 31), as  
 5 follows:

6 **PARTIES, JURISDICTION, AND VENUE**

7 1. Upon information and belief, OPENWAVE admits that MYRIAD FRANCE  
 8 S.A.S. is a French corporation having its principal place of business in France.

9 2. OPENWAVE admits that OPENWAVE is a Delaware corporation with its  
 10 principal place of business in Redwood City, California.

11 3. OPENWAVE admits that this Court has jurisdiction over the subject matter of this  
 12 action and over the parties to this action. OPENWAVE denies each and every other allegation in  
 13 paragraph 3.

14 4. OPENWAVE admits that venue is proper in this judicial district.

15 **GENERAL ALLEGATIONS**

16 5. OPENWAVE lacks knowledge or information sufficient to form a belief about the  
 17 allegations in paragraph 5 and, for that reason, denies the allegations.

18 6. OPENWAVE admits that OPENWAVE and Purple Labs, S.A. (“PURPLE  
 19 LABS”) entered into an Asset Purchase Agreement dated as of June 27, 2008 (the “APA”).  
 20 OPENWAVE admits that OPENWAVE and PURPLE LABS entered into an Intellectual Property  
 21 License Agreement dated June 27, 2008 (the “IPLA”). OPENWAVE denies each and every other  
 22 allegation in paragraph 6.

23 7. OPENWAVE admits that OPENWAVE and PURPLE LABS participated in  
 24 negotiations prior to executing APA and IPLA. OPENWAVE admits that the IPLA recites that  
 25 “[OPENWAVE] wishes to sell to [PURPLE LABS], and [PURPLE LABS] desires to purchase  
 26 from [OPENWAVE], certain assets owned by [OPENWAVE] necessary to continue the Business  
 27 on the terms set forth” in the IPLA. IPLA at B. OPENWAVE admits that Exhibit A to the APA  
 28 is entitled Certain Definitions and provides, in part:

1           **“Business”** shall mean the mobile client software business of  
 2 [OPENWAVE], and its direct and indirect subsidiaries, that  
 3 develops, distributes, markets, sells, licenses, and supports various  
 4 handset software clients such as browsers, SMS, EMS and MMS  
 5 and email messaging clients, java clients, UI, widgets, graphics  
 6 engines and other software designed for mobile handsets.  
 7

8 OPENWAVE admits that it retained what the IPLA defines as “Seller’s Remaining Business.”  
 9

10 OPENWAVE admits that Exhibit A to the APA is entitled Certain Definitions and provides, in  
 11 part:  
 12

13           **“Seller’s Remaining Business”** shall mean (a) all of  
 14 [OPENWAVE’s] business activities prior to the Closing except for  
 15 the Business; and (b) all of [OPENWAVE’s] future business  
 16 activities other than the development, distribution, marketing, sale,  
 17 license, and support of handset software clients such as browsers,  
 18 messaging clients, java clients, UI, widgets, graphics engines and  
 19 other software designed for mobile handsets.  
 20

21 OPENWAVE denies each and every other allegation in paragraph 7.  
 22

23           8. OPENWAVE admits that OPENWAVE and PURPLE LABS participated in  
 24 negotiations prior to executing APA and IPLA. OPENWAVE admits that Section 1.1 of the APA  
 25 provides, in part:  
 26

27           **Purchase and Sale of Assets.** [OPENWAVE] shall sell, assign,  
 28 transfer, convey and deliver to [PURPLE LABS] or its designee,  
 29 and [PURPLE LABS] shall purchase, acquire and accept from  
 30 [OPENWAVE], at the Closing, all of [OPENWAVE’S] and  
 31 [OPENWAVE’S] Subsidiaries’ right, title and interest in, to and  
 32 under the Assets on the terms and subject to the conditions set forth  
 33 in this Agreement . . . . For purposes of this Agreement, “Assets”  
 34 shall mean all of the equipment, Assigned Contracts, Seller IP and  
 35 other tangible and intangible assets of [OPENWAVE] set forth on  
Schedule 1.1(a) attached hereto and any Contract assumed by  
 36 [PURPLE LABS] pursuant to Section 6.1(b).  
 37

38 OPENWAVE admits that Exhibit A to the APA is entitled Certain Definitions and provides, in  
 39 part:  
 40

41           **“Seller IP”** shall mean the Intellectual Property listed on Schedule  
 42 1.1 and all Intellectual Property Rights therein.  
 43

44 OPENWAVE denies each and every other allegation in paragraph 8.  
 45

46           9. OPENWAVE admits that OPENWAVE provided PURPLE LABS with the  
 47 presentation entitled “Overview of Client Business” attached as Exhibit 1 to MYRIAD’S Answer  
 48

1 to Second Amended complaint and First Amended Counterclaim. OPENWAVE denies each and  
 2 every other allegation in paragraph 9.

3       10. OPENWAVE admits that OPENWAVE provided PURPLE LABS with the  
 4 presentation entitled “Overview of Client Business” attached as Exhibit 1 to MYRIAD’S Answer  
 5 to Second Amended complaint and First Amended Counterclaim. Openwave admits that the  
 6 presentation includes the quoted language. Openwave denies that the presentation represents the  
 7 patents that the parties to the APA and IPLA intended to be assigned to PURPLE LABS.  
 8 OPENWAVE denies each and every other allegation in paragraph 10.

9       11. OPENWAVE admits that OPENWAVE provided PURPLE LABS with the  
 10 presentation entitled “Overview of Client Business” attached as Exhibit 1 to MYRIAD’S Answer  
 11 to Second Amended complaint and First Amended Counterclaim. Openwave admits that the  
 12 presentation includes the quoted language. Openwave denies that the presentation represents the  
 13 patents that the parties to the APA and IPLA intended to be assigned to PURPLE LABS.  
 14 OPENWAVE denies each and every other allegation in paragraph 11.

15       12. OPENWAVE admits that OPENWAVE and PURPLE LABS participated in  
 16 negotiations prior to executing APA and IPLA. OPENWAVE denies each and every other  
 17 allegation in paragraph 12.

18       13. OPENWAVE admits that both PURPLE LABS and OPENWAVE wanted to  
 19 execute the APA and IPLA on or before June 30, 2008. OPENWAVE denies each and every  
 20 other allegation in paragraph 13.

21       14. OPENWAVE admits that sections 1.3 and 2.4 of the IPLA are both entitled  
 22 “Missing Assigned Patents.” OPENWAVE denies each and every other allegation in paragraph  
 23 14.

24       15. OPENWAVE admits that Section 2.4 of the IPLA provides:

25           **Missing Assigned Patents.** From time to time, Purple Labs may  
 26 become aware of the existence of a Missing Assigned Patent. For  
 27 those Missing Assigned Patents that Purple Labs identifies to  
 28 Openwave and are confirmed by Openwave to comply fully with  
 the definition of an Missing Assigned Patent, Openwave shall  
 assign all of its right, title and interest in such Missing Assigned  
 Patents to Purple Labs and shall execute a patent assignment

1                   substantially in the form of Exhibit B for such Missing Assigned  
 2                   Patents.

3                   OPENWAVE denies each and every other allegation in paragraph 15.

4                   16.       OPENWAVE admits that Section 1.3 of the IPLA provides:

5                   **“Missing Assigned Patents”** means patents owned by Openwave  
 6                   immediately prior to the execution of the APA (or patents issuing  
 7                   on patent applications owned by Openwave immediately prior to  
 8                   the execution of the APA) that (a) contain claims that, immediately  
 9                   prior to the execution of the APA, cover products or services in the  
 10                  “Business” (as defined in the APA) but do not cover products or  
 11                  services in the Openwave Field of Use; and (b) were not assigned to  
 12                  Purple Labs as “Seller IP” pursuant to the APA.

13                  OPENWAVE denies each and every other allegation in paragraph 16.

14                  17.       OPENWAVE admits that Exhibit A to the APA is entitled Certain Definitions and  
 15                  provides, in part:

16                  **“Business”** shall mean the mobile client software business of  
 17                  [OPENWAVE], and its direct and indirect subsidiaries, that  
 18                  develops, distributes, markets, sells, licenses, and supports various  
 19                  handset software clients such as browsers, SMS, EMS and MMS  
 20                  and email messaging clients, java clients, UI, widgets, graphics  
 21                  engines and other software designed for mobile handsets.

22                  OPENWAVE denies each and every other allegation in paragraph 17.

23                  18.       OPENWAVE admits that Section 1.9 of the IPLA provides:

24                  **“Openwave Field of Use”** means the development, distribution,  
 25                  marketing, sale, licensing, and support of server software sold to  
 26                  mobile operators and broadband operators for the purpose of (a)  
 27                  messaging (MMSC) and email; (b) content delivery; (c) advertising  
 28                  distribution; (d) coupling of wired to wireless networks and the  
 29                  transfer of messages and data between those types of networks; or  
 30                  (e) location related data services, including location determination  
 31                  and location filtering of data services.

32                  OPENWAVE denies each and every other allegation in paragraph 18.

33                  19.       OPENWAVE admits that MYRIAD’s counsel sent OPENWAVE a letter dated  
 34                  July 27, 2010, attached as Exhibit 1 to OPENWAVE’s Second Amended Complaint.

35                  OPENWAVE admits that the letter purports to identify ten OPENWAVE patents as alleged  
 36                  missing assigned patents. OPENWAVE denies each and every other allegation in paragraph 19.

1           20. OPENWAVE alleges that in good faith it considered MYRIAD's request for  
 2 assignment of the patents listed in MYRID'S July 27, 2010's letter. OPENWAVE admits that it  
 3 filed its Second Amended Complaint on November 10, 2010. OPENWAVE admits that the First  
 4 Claim for Relief in its Second Amended Complaint is entitled "Declaratory Judgment Re:  
 5 Purported Missing Assigned Patent" which states, in relevant part:

6           MYRIAD contends that OPENWAVE is required by certain  
 7 provisions by the IPLA and APA to assign ten patents to MYRIAD.  
 8 OPENWAVE rejects MYRIAD's claim to these patents . . . .  
 9 Pursuant to the Declaratory Judgment Act, 28 U.S.C. § 2201 *et*  
*seq.*, OPENWAVE requests a declaration that MYRIAD is not  
 entitled to an assignment of the patents identified in MYRIAD's  
 July 27, 2010 letter.

10          Second Amended Complaint ¶¶ 16-17. OPENWAVE denies each and every other allegation in  
 11 paragraph 20.

12          21. OPENWAVE denies each and every other allegation in paragraph 21.  
 13          22. OPENWAVE denies each and every other allegation in paragraph 22.

#### 14                   **FIRST CLAIM FOR RELIEF**

##### 15                   **Declaratory Judgment**

16          23. OPENWAVE admits that MYRIAD purports to reallege paragraphs 1 through 22  
 17 of its First Amended Counterclaim in paragraph 23.

18          24. OPENWAVE admits the allegations in paragraph 24.  
 19          25. OPENWAVE denies the allegations in paragraph 25.

#### 20                   **SECOND CLAIM FOR RELIEF**

##### 21                   **Specific Performance**

22          26. OPENWAVE admits that MYRIAD purports to reallege paragraphs 1 through 25  
 23 of its First Amended Counterclaim in paragraph 26.

24          27. OPENWAVE cannot admit or deny the allegations in paragraph 27.  
 25          28. OPENWAVE denies the allegations in paragraph 28.  
 26          29. OPENWAVE denies the allegations in paragraph 29.

#### 27                   **THIRD CLAIM FOR RELIEF**

##### 28                   **Attorneys' Fees and Costs**

30. OPENWAVE admits that MYRIAD purports to reallege paragraphs 1 through 29 of its First Amended Counterclaim in paragraph 30.

31. OPENWAVE admits that Section 6.5 of the IPLA provides:

**Attorneys' Fees.** If any legal action or other legal proceeding relating to any of the Transaction Documents or the enforcement of any provision of the Transaction Documents is brought against any party to this Agreement, the prevailing party shall be entitled to recover reasonable attorneys' fees, costs and disbursements (in addition to any other relief to which the prevailing party may be entitled).

32. OPENWAVE admits that it is not required to assign the “Identified Missing Assigned Patents” to MYRIAD. OPENWAVE admits that it filed the present lawsuit. OPENWAVE denies each and every other allegation in paragraph 32.

33. OPENWAVE denies the allegations in paragraph 33.

## PRAAYER FOR RELIEF

34. OPENWAVE denies that MYRIAD is entitled to the requested relief.

## **AFFIRMATIVE DEFENSES**

Further answering MYRIAD's Counterclaims, OPENWAVE asserts the following defenses. OPENWAVE reserves the right to amend this Answer to MYRIAD's First Amended Counterclaims with additional defenses as further information is obtained.

## **FIRST AFFIRMATIVE DEFENSE**

## (Failure to State a Claim)

35. MYRIAD's Counterclaims fail to state a claim upon which relief can be granted.

## **SECOND AFFIRMATIVE DEFENSE**

### (Unenforceability)

36. MYRIAD's Counterclaims fail because the Missing Assigned Patents Clause is unenforceable.

### **THIRD AFFIRMATIVE DEFENSE**

(Adequate Remedy at Law)

37. MYRIAD's Counterclaims for specific performance are barred in light of the fact that MYRIAD has an adequate remedy at law.

## **FOURTH AFFIRMATIVE DEFENSE**

(Laches/Estopel)

38. MYRIAD's Counterclaims are barred or limited by the doctrine of laches and/or equitable estoppel.

**FIFTH AFFIRMATIVE DEFENSE**  
(Failure to Timely Exercise Purported Rights)

39. MYRIAD's Counterclaims are barred or limited because MYRIAD failed to exercise the Missing Assigned Patents Clause in a timely fashion.

## **SIXTH AFFIRMATIVE DEFENSE** (Lack of Standing)

40. MYRIAD's Counterclaims are barred or limited because MYRIAD lacks standing to bring the Counterclaims against OPENWAVE.

## **SEVENTH AFFIRMATIVE DEFENSE**

(Unjust Enrichment)

41. MYRIAD's Counterclaims are barred or limited because MYRIAD would be unjustly enriched if allowed to recover the relief sought.

## **EIGHTH AFFIRMATIVE DEFENSE** (Waiver)

42. MYRIAD's Counterclaims are barred or limited because MYRIAD knowingly and voluntarily waived any purported causes of action that it may have had against OPENWAVE.

## **NINTH AFFIRMATIVE DEFENSE**

(Unclean Hands)

43. MYRIAD's Counterclaims are barred or limited by the unclean hands of MYRIAD with respect to the matters alleged in the Counterclaims.

## **PRAAYER FOR RELIEF**

WHEREFORE, OPENWAVE prays that this Court enter a judgment on MYRIAD's Counterclaims:

- A. that MYRIAD take nothing for relief;
- B. that MYRIAD's claims be dismissed with prejudice;
- C. that OPENWAVE be awarded its attorneys' fees and costs in this action; and

D. for such other and further relief as the Court deems just and equitable.

Dated: December 27, 2010

MORGAN, LEWIS & BOCKIUS LLP

/s/ Brett M. Schuman

---

Brett M. Schuman  
Attorneys for Plaintiff  
OPENWAVE SYSTEMS INC.